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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,207	12/03/2003	David Schlesinger	LOT920030026US1 (011)	5185
46321 7590 02/24/2009 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487				
EXAMINER McCORMICK, GABRIELLE A				
ART UNIT 3629		PAPER NUMBER		
MAIL DATE 02/24/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/727,207

**Applicant(s)**

SCHLESINGER ET AL.

**Examiner**

Gabrielle McCormick

**Art Unit**

3629

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 2 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-893)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 12/3/2003

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the application filed on December 3, 2003.
2. Claims 1-12 are currently pending and have been examined.

### ***Information Disclosure Statement***

3. The Information Disclosure Statement filed on December 3, 2003 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### ***Claim Objections***

4. Claims 2 and 10 are objected to for failing to end in a period.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-5 are rejected as being directed to non-statutory subject matter. Claims 1 and 5 are method claims that recite process steps that are not tied to a particular machine. Based on recent Federal Circuit decision (see *In re Bilski*), an applicant may show that a process claim satisfies 35 USC 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. (See Benson, 409 U.S. at 70). First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See Flook, 437 U.S. at 590).
7. Claims 1 and 5 do not recite the use of any machine implementation, rather, they recite method steps that can be implemented by a human being. The term "metadata" is not limited to a computer-related application.

8. Because the applicable test to determine whether a claim is drawn to a patent-eligible process under 35 USC 101 is the machine-or-transformation test set forth by the Supreme Court, claims 1 and 5 fail that test and is therefore rejected under 35 USC 101. Claims 2-4 are rejected through dependency from claim 1.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-6 and 8-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirpe et al. (US Pub. No. 2002/0087496, hereinafter referred to as "Stirpe") in view of Menon et al. (US Pub. No. 2002/0152318, hereinafter referred to as "Menon").
11. **Claims 1 and 9:** Stirpe discloses a *method for selectively applying course content updates in a learning management system, the method comprising the step of processing an update to course metadata* (P[0083]: the "characteristics" are understood to be examples of metadata).
12. Stirpe does not disclose that the updating to the metadata is processed separately from the content.
13. Menon, however, discloses loading or updating metadata separately from the content it is associated with. (P[0064]).
14. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included separately updating metadata from content, as disclosed by Menon in the system disclosed by Stirpe, for the motivation of providing a method of lowering the costs associated with distributing content using bandwidth. (Menon; P[0024] and [0034]).
15. **Claims 2 and 10:** Stirpe discloses

- *identifying within a course package a course metadata update to an associated course master;* (P[0083]: the knowledge component and characteristics comprise the "course package". The characteristics are updated.)
- *determining whether to wholly reject said course metadata update to said associated course master, or to apply said course metadata update to said associated course master;* (P[0085-0086]: updates are not applied if errors exist and updates are reviewed to determine whether to apply or not.)
- *further determining whether to apply said course metadata update to existing course offerings based upon said associated course master, or whether to exempt said existing course offerings from said course metadata update* (P[0086]: the content management system helps the author determine how/when/to whom updates should be applied, thus determining whether to exempt existing course offerings from the update.)

**16. Claims 3 and 11:** Stirpe discloses

- *extracting a package identifier for said course package;* (P[0126-0127]: each knowledge component and session has a unique number).
- *comparing said identifier with other identifiers associated with existing course masters disposed within the learning management system; and,* (P[0086]: updates are selectively applied, thus the comparison of identifiers is inherent in the selective updating process.)
- *performing said identifying, determining and further determining steps only where said comparison indicates that said course package incorporates said update.* (P[0086]: updates are selectively applied, thus the comparison of identifiers is inherent in the selective updating process.)

**17. Claims 4 and 12:** Stirpe discloses updating knowledge components and characteristics (i.e., course masters) in a selective manner such that not all updates are applied (P[0086]), but does not explicitly disclose a *listing*.

**18.** Menon, however, discloses a "scheduled push" of metadata. (P[0071]). It is inherent is scheduling a push of metadata that a listing would be employed.

19. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a listing, as disclosed by Menon, in the system of Stirpe for the motivation of minimizing the cost and/or disruption to other network activity. (Menon; P[0071]).
20. **Claim 5:** Stirpe discloses
- *authoring a course metadata update to an existing course deployed within the learning management system;* (P[0079]: the characteristics are altered (i.e., an update is authored); P[0083]: the expert updates the characteristics and P[0085]: trainers author knowledge components).
  - *packaging said course metadata update in a course package and importing said course package into the learning management system;* (P[0086])
  - *selecting whether to apply said course metadata update to all course offerings for said existing course, or only to new course offerings for said existing course.* (P[0086]: the content management system helps the author determine how/when/to whom updates should be applied, thus determining whether to exempt existing course offerings from the update.)
21. Stirpe does not disclose that the updating to the metadata is processed separately from the content.
22. Menon, however, discloses loading or updating metadata separately from the content it is associated with. (P[0064]).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included separately updating metadata from content, as disclosed by Menon in the system disclosed by Stirpe, for the motivation of providing a method of lowering the costs associated with distributing content using bandwidth. (Menon; P[0024] and [0034]).
24. **Claim 6:** Stirpe discloses
- *a learning management server coupled to a delivery server;* (Fig. 1 and P[0091]: knowledge exchange service comprises the server)

- *a database coupled to said learning management server and configured to store course masters arranged to describe course offerings for deployment in said delivery server; (Fig. 1 and P[0080]).*
  - *update logic disposed within said learning management server, said update logic comprising programming for selectively updating course offerings disposed in said delivery server with one of updated course metadata alone, updated course content alone, and both updated course metadata and course content, based upon a course update package uploaded into said learning management server. (P[0086]).*
25. Stirpe does not disclose that the updating to the metadata is processed separately from the content.
26. Menon, however, discloses loading or updating metadata separately from the content it is associated with. (P[0064]).
27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included separately updating metadata from content, as disclosed by Menon in the system disclosed by Stirpe, for the motivation of providing a method of lowering the costs associated with distributing content using bandwidth. (Menon; P[0024] and [0034]).
28. **Claim 8:** Stirpe discloses that the knowledge exchange service is utilized for delivery of the knowledge components. (P[0092]). Further, Stirpe discloses that users can search for specific course offerings, thus the delivery is response to a user request. (P[0091]).
29. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Stirpe et al. (US Pub. No. 2002/0087496, hereinafter referred to as "Stirpe") in view of Menon et al. (US Pub. No. 2002/0152318, hereinafter referred to as "Menon") in further view of Theilmann et al. (US Pub. No. 2003/0175676, hereinafter referred to as "Theilmann").
30. **Claim 7:** Stirpe discloses that update packages are authored (P[0079]: the characteristics are altered (i.e., an update is authored); P[0083]: the expert updates the characteristics and P[0085]: trainers author knowledge components), but does not disclose an *authoring tool*.

31. Theilmann, however, discloses an authoring tool (P[0079-0086] and Fig. 7).
32. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included an authoring tool, as disclosed by Theilmann, in the system of Stirpe for the motivation of providing the means for the experts, trainers and contributors from the institutions to create the content. It is clear that Stirpe discloses that content and metadata are authored, therefore it is obvious to expand Stirpe to include the means by which this takes place.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./  
Examiner, Art Unit 3629

/John G. Weiss/  
Supervisory Patent Examiner, Art Unit 3629